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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,262

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Giuseppe Bordinon

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EXAMINER

KRUER, STEFAN

ART UNIT

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3654

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/597,262	BORDIGNON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stefan Krueer	3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17 - 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17 - 22, 26 and 29 - 32 is/are rejected.
- 7) ☒ Claim(s) 23 - 25 and 27 - 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

A certified copy of the priority Application No. UD2004A000007 has been received.

An amendment to the first sentence(s) of the specification to make reference to the prior application is acknowledged.

### ***Specification***

Though referenced in applicant's amendment filed 5 December 2008 as having been filed, an abstract of the disclosure commencing on a separate sheet has not been received.

### ***Drawings***

Corrected drawing sheets in compliance with 37 CFR 1.121(d) have been received and are accepted.

### ***Terminal Disclaimer***

The terminal disclaimers filed on 5 December 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Numbers 10/597228 and 10/597184 have been reviewed and are accepted. The terminal disclaimers have been recorded.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 26** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 26** recites the limitation "the protrusion... is substantially equal to a value..." whereby said protrusion, as understood, is a structure that cannot have a value. As understood from the disclosure, the protrusion has a dimension (e.g., thickness or height) in relation to a diameter of a metal product.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 17 – 22 and 29 - 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bordignon et al (6,318,660).

**Re: Claim 17**, Bordignon et al disclose a device (10, Fig. 1) for coiling a windable long, metal product (12), comprising:

- a mandrel (20) having a substantially circular transverse section and rotating around a horizontal, vertical or inclined axis (about 20a),
- a containing element (24) to contain said metal product, arranged in correspondence with said mandrel and including at least a lateral wall (surface along indicating line for "24") at least partially extending substantially orthogonal to said axis,
- and at least a guide and containing device (39 and/or 40) able to be driven between a first working position in which said guide and containing device cooperates with said mandrel (Col. 4, L. 14 – 18), and a second inactive position in which said guide and containing device is arranged distant from said mandrel (Col. 4, L. 18 - 22),
- wherein lateral wall of said containing element defines, together with an outer surface of said mandrel an annular channel which is made in proximity with

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an outer surface of said mandrel and is coaxial with the axis of rotation of said mandrel (Col. 4, L. 12 – 23).,

- and wherein said guide and containing device includes a groove that is able to define an accompanying guide for said metal product along an outer circumference of said mandrel towards said annular channel and coaxial with said annular channel, when said guide and containing device is in said first working position. (Col. 4, L. 12 – 23).

**Re: Claims 18 - 19**, Bordignon et al disclose:

- wherein said annular channel has a substantially rectangular transverse section (Col. 1, L. 6),
- wherein said annular channel has a substantially trapezoid section (Col. 1, L. 6), respectively.

**Re: Claims 20 - 22**, Bordignon et al disclose:

- wherein said guide and containing device comprises at least a first flap (39),
- wherein said guide and containing device comprises a second flap (40) arranged diametrically opposite said first flap, and
- wherein said first and second flap constitute, in said first working position, a lateral cover to said annular channel (Col. 5, L. 7), respectively.

**Re: Claim 29**, Bordignon et al disclose a method for coiling a long metal product, performed by means of a coiling device (10) which includes:

- a mandrel (20) having a substantially circular transverse section and rotating around a horizontal, vertical or inclined axis,
- a containing element (24) to contain said metal product, arranged at one end of said mandrel and including at least a lateral wall (surface along indicating line for “24”) at least partially extending substantially orthogonal to said axis, and at least one guide and containing device (39 and/or 40), able to be driven between a first working position in which said guide and containing device

- cooperates with said mandrel, and a second inactive position in which said guide and containing device is arranged distant from said mandrel,
- said method comprising the following steps:
- a first step wherein a leading end of said metal product is inserted into a groove of said guide and containing device arranged in said first working position to guide said metal product along an outer circumference of said mandrel;
  - a second step wherein said metal product is guided by said groove inside an annular channel defined between said lateral wall of said containing element in proximity with an outer surface of said mandrel and coaxially with said axis of rotation of said mandrel;
  - a third step wherein an initial segment of said metal product is gripped and clamped in said annular channel by means of friction forces generated between said metal product and the walls of said annular channel;
  - a fourth step wherein said metal product is wound onto said mandrel for a pre-determined segment of length (Col. 5, L. 8);
  - a fifth step wherein said guide and containing device is taken from said first working position to said second inactive position (Col. 5, L. 10); and
  - a sixth step wherein said metal product is wound for the remainder of its length (Col. 21 – 27).

**Re: Claim 30**, Bordignon et al disclose wherein during said first step, said metal product is inserted into said groove by means of a distributor (45) of said metal product.

**Re: Claim 31**, Bordignon et al disclose wherein during said first step, said mandrel is in rotation around its own axis.

**Re: Claim 32**, Bordignon et al disclose wherein said segment of pre-determined length is between a fraction of one spiral and three spirals (Col. 5, L. 8).

With respect to a rejection under obviousness in lieu of anticipation, in view of the claimed "annular channel" and "groove", in that the apparatus of Bordignon et al

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discloses an apparatus performing in the manner as claimed and broadly as disclosed by the instant invention, though silent with respect to an annular channel and groove, in view of the "... rolled stock 12 is... to enter into the inner cavities of the guides.... and to be guided in the coiling step of the first revolutions of the mandrel" and that retaining the rolled stock is inherent to frictional interaction of the rolled stock with the "wear-resistant materials" that comprise the "inner cavities of the guides", the instant invention as claimed in view of Bordignon et al would have been obvious to one having ordinary skill in the art.

### ***Allowable Subject Matter***

**Claims 23 – 25 and 27 - 28** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claim 26** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as well as to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, as set forth in this Office action.

### ***Response to Arguments***

Applicant's arguments filed 5 December 2008 have been fully considered but they are not persuasive.

The rejections were made in response to the claim language, as understood. The amended claim language, notably "... at least a lateral wall at least partially extending substantially orthogonal to said axis..." can be interpreted as the outer surface of the containing element that extends vertically and laterally in a semi-circular path above the mandrel.

Furthermore, as understood, the containing element forms an annular chamber about the mandrel and the guide and containing device, as understood, forms an

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annular chamber or groove as well, based on its structure and function, the latter as acknowledged by applicant (Page 15 of 16, L. 13).

With respect to the rejection of Claim 26 under USC 35, 112, 2<sup>nd</sup> paragraph, the rejection has been rephrased for further specificity, thereby requiring amendment in the spirit of applicant's arguments (Page 14, Line 4).

Neither the original claim language nor the amended claim language overcame the rejections based on the prior art of record of the previous office action.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Castellani (7,246,767) is cited for a device for coiling a long metal product wherein a flange is applied on a containing element substantially perpendicular to a mandrel and shaped so as to have an annular tooth substantially coaxial with said mandrel, said annular tooth defining at a lower part an annular channel and said tooth is slightly convergent towards an outside.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Kruer whose telephone number is 571.272.5913. The examiner can normally be reached on M-F.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571.272.6856. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

/Stefan Kruer/

Examiner, Art Unit 3654

23 February 2009

/Peter M. Cuomo/

Supervisory Patent Examiner, Art Unit 3654